

REMARKS

Claims 1, 4-11, 16 and 18-23 are pending in the application. Claim 18 is herein amended to place the application in better condition for examination. No new matter has been entered. It is respectfully submitted that this Amendment is fully responsive to Office Action dated June 4, 2007. Favorable reconsideration of this rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. §112

Claim 18 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants have removed the word "directly" from the claim. As such, Applicants submit that the amendment addresses the Examiner's rejection and is fully compliant with 35 U.S.C. §112.

On the Merits

Claim Rejections - 35 U.S.C. §102

Claims 18 and 20-23 are rejected under 35 U.S.C. §102(e) as being anticipated by *Masuda* (USPGPUB 2002/0172031).

Independent Claim 18

Cited reference *Masuda* (US 2002/0172031 A1) discloses a structure wherein light entered from a light source is propagated through a light guiding part and subsequently the light thus propagated is guided from a surface to the outside (a reflective-type liquid crystal display), the surface being opposite to a surface on which a touched position is detected (see Fig. 24). By referring to the description in paragraph [0153] of *Masuda*, the Examiner indicated a step-like

structure formed on a light guide plate of *Masuda* corresponds to a light guiding and emitting part of the present claim 18.

However, although paragraph [0153] indicated by the Examiner states that a light guide plate has concaves and convexes at the surface on the viewer side, the relevant portion does not describe that the step-like structure is positioned on the crystal liquid display side. Therefore, Applicants have limited claim 18 to state "the step-like structure is positioned on a surface opposing to a surface where a touched position is to be detected".

As such, Applicants respectfully submit that claim 18 is presently in condition for allowance.

Dependent Claims 20-23

As claims 20-23 are directly or indirectly dependent on claim 18 and are limited to the additional features set forth therein, Applicants respectfully submit that claims 20-23 are not anticipated by *Masuda* for the reasons set forth above.

Claim Rejections - 35 U.S.C. §103

Claims 1, 4, 6, 16 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Masuda* (USPGPUB 2002/0172031) in view of *An* (USPGPUB 2002/0154250).

Independent Claim 1

The Office Action dated June 4, 2007 largely relies on the analysis previously set forth in rejecting claim 1. In the current office action, the Examiner acknowledges that the references fail

to teach the touch panel and light guide integrated as one substrate. However, the Examiner argue that this feature would be obvious, even though it is not disclosed in any of the cited references. In addition, the Examiner relies on *In re Larson*¹ in order to argue that claim 1 is unpatentable over *Masuda* in view of *An*.

The Examiner uses the decision of *In re Larson*, as in the previous Office Actions, to argue that at the time the invention was made it would have been obvious to one skilled in the art to combine the substrates taught in *An* and *Masuda*. Applicants incorporate by reference the previously submitted responses, and submit the following arguments. Applicants also respectfully submit that the decision of *Schenck v. Norton Corp.*² is more applicable and on point.

Unlike the cited references in *Larson*, neither *Masuda* nor *An* teaches or suggests the advantage of reducing manufacturing costs by combining substrates. In *Masuda*, the disclosure teaches two separate light guiding parts and how to efficiently manufacture those parts *separately* (see paragraphs 0136 and 0145). *An* makes no mention of combining substrates to reduce the costs of manufacturing. In order to support the argued position, Applicants respectfully submit that the Examiner must present references that teach the improvement of reducing the number of optical interfaces to reduce manufacturing costs.

¹ 340 F.2d 965, 144 USPQ 347 (CCPA 1965).

² *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the

The Applicant's disclosure does not teach the reduction of manufacturing costs as the Examiner suggests on pages 5 and 7 of the Final Office Action. In fact, Applicant's disclosure teaches the opposite to be true. In paragraph 0022 of the application it is disclosed that the production process is simple when the touch panel and a substrate are produced separately and then bonded together using an adhesive agent. No part of the Applicant's disclosure discusses manufacturing costs in relation to combining the two substrates. Therefore, Applicants submit that the Examiner is required to provide support, in the form of prior art references, for the above assertion that it would have been obvious to combine the substrates.

In addition, Applicants ask the Examiner to present support for the statement that "it is common knowledge to one of ordinary skill in the art that combining two optical substrates reduces the optical interfaces and yields better visibility due to the fact that the light has less obstruction to pass through" (see page 11, first paragraph of the Office Action dated June 4, 2007). If the Examiner is taking official notice of the above statement, then Applicants respectfully request the Examiner to provide support under MPEP 2144.03.

Dependent Claims 4 and 6

Claims 4 and 6 are directly dependent on claim 1 and are limited to the additional features set forth therein. Accordingly, claims 4 and 6 are patentable over *Masuda* in view of *An* for the reasons set forth above.

inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.

Independent Claim 16

The arguments presented by the Examiner are largely the same for claims 1 and 16. Therefore, Applicants submit that claim 16 is patentable over *Masuda* in view of *An* for the reasons set forth above.

Dependent Claim 19

As claim 19 is directly dependent on claim 18, the rationale presented above regarding claim 18 also applies to claim 19. Therefore, Applicants submit that dependent claim 19 is in condition for allowance.

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable of *Masuda* and *An* and further in view of *Nakabayashi et al.* (USPGPUB 2001/0019479).

Dependent Claim 5

Claim 5 is directly dependent on claim 4 and is limited to the additional features set forth therein. Accordingly, claim 5 is patentable over *Masuda* and *An* and further in view of *Nakabayashi* for the reasons set forth above.

Claims 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Masuda* and *An* and further in view of *Fumiaki et al.* (JP 06-235917).

Dependent Claim 7

Claim 7 is directly dependent on claim 1 and is limited to the additional features set forth therein. Accordingly, claim 7 is patentable over *Masuda* for the reasons set forth above.

Dependent Claim 8

Claim 8 is directly dependent on claim 7 and is limited to the additional features set forth therein. Accordingly, claim 8 is patentable over *Masuda* for the reasons set forth above.

Claims 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Masuda* and *An* and further in view of *Ito et al.* (US Patent 6,892,009).

Dependent Claim 9

Claim 9 is directly dependent on claim 1 and is limited to the additional features set forth therein. Accordingly, claim 9 is patentable over *Masuda* for the reasons set forth above.

Dependent Claim 10

Claim 10 is directly dependent on claim 9 and is limited to the additional features set forth therein. Accordingly, claim 10 is patentable over *Masuda* for the reasons set forth above.

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Masuda* and *An* and further in view of *Kubo et al.* (U.S. Patent 6,456,279).

Dependent Claim 11

Claim 11 is directly dependent on claim 1 and is limited to the additional features set forth therein. Accordingly, claim 11 is patentable over *Masuda* and *An* and further in view of *Kubo* for the reasons set forth above.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein presented, are in condition for allowance. Applicants

Response After Final
Application No. 10/642,640
Attorney Docket No. 030931

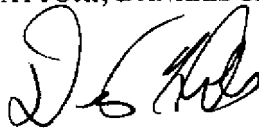
request such action at an early date. Favorable reconsideration of this rejection is earnestly solicited.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned agent to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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